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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,310	08/21/2001	G. David Jang	S63.2-10078	8078
490 7590 09/30/2008 VIDAS, ARRETT & STEINKRAUS, P.A. SUITE 400, 6640 SHADY OAK ROAD EDEN PRAIRIE, MN 55344				
EXAMINER				
PREBILIC, PAUL B				
ART UNIT		PAPER NUMBER		
3774				
MAIL DATE		DELIVERY MODE		
09/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/934,310

**Applicant(s)**

JANG, G. DAVID

**Examiner**

Paul B. Prebille

**Art Unit**

3774

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 50-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 50-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Reopening of Prosecution***

An appeal conference was held on September 8, 2008, and the majority of the conferees agreed with the Appellant's positions taken in the appeal brief filed July 15, 2008. For this reason, the previous rejections of record have been withdrawn. Therefore, PROSECUTION IS HEREBY REOPENED. New grounds of rejections are set forth below based upon a new piece of prior art.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/DAVID J ISABELLA/

Supervisory Patent Examiner, Art Unit 3774.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 54 and 55 are rejected under 35 U.S.C. 102(e) as being anticipated by Kleshinski et al (US 5,540,712). Kleshinski anticipates the claim language where the stent as claimed is stent (24) of Kleshinski, and the diameter and taper as claimed is best shown in Figure 10 and disclosed on column 7, lines 41-62. The stent (24) of Kleshinski clearly tapers along most of the length thereof. The annular elements as claimed are made of circumferentially adjacent cells. The decreasing longitudinal length is met by the cells of end (30) that have fingers making them longer than the cells axially adjacent thereto.

Even though the figures are not disclosed as being drawn to scale, the cells of the larger end are made to be larger; see column 7, lines 41-62. The maximum longitudinal length of a cell on end (30) measured 8 mm while a cell on the small end measured 4 mm. This pronounced difference is sufficient enough to suggest that the longitudinal length of an end cell at end (30) is greater than the longitudinal length of a cell at the small end.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 50-53 are rejected under 35 U.S.C. 102(e) as anticipated by Kleshinski et al (US 5,540,712) or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kleshinski et al (US 5,540,712) in view of Limon et al (US 6,027,526). Kleshinski meets the claim language as suggested in the previous rejection. It is noted that the cell struts are made longer in the embodiment of Figure 4 in order to reduce the compressive force; see Figure 4 and column 4, lines 25-45. In addition the cell struts can be made with thicker wire to increase the radial force; see column 7, line 62 to column 8, line 7 and Figure 11. Furthermore, the different diameter sections can be made to have substantially equal outward radial forces; see column 7, line 41-62. Therefore, the different degree of flexibility of different diameter sections (see the last two lines of claims 50 and 52) is encompassed by the language "substantially equal" of Kleshinski.

Alternatively, if one views the different flexibility language (the last two lines of claims 50 and 52) as not be met by "substantially equal" of Kleshinski, the Examiner asserts that the Limon teaches that it was known to the art to make one end to have a different flexibility than another end; see Figures 17 and 18 and column 7, lines 24-46 of Limon. Therefore, it would have been obvious to an ordinary artisan to make one end of Kleshinski to have a different flexibility than the other end for the same reasons that Limon does the same.

Regarding claims 52 and 53, the preamble requires a stent cut from a tube. Kleshinski teaches making a stent from a flat sheet that is joined to form a tube after a

pattern is formed therein; see column 5, lines 6-12. The Examiner asserts that this process results in the same structure as a stent cut from a tube.

Alternatively, the claimed product-by-process steps may result in a product that is substantially identical to that of Kleshinski. Nonetheless, the Examiner asserts that the final product would be so similar to the device disclosed by Kleshinski that it would have been considered clearly obvious in view of Kleshinski alone; see MPEP 2113 that is incorporated herein by reference.

### ***Conclusion***

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilic whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Isabella can be reached on 571-272-4749. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Paul Prebilic/  
Paul Prebilic  
Primary Examiner  
Art Unit 3774